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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,970	12/04/2003	Shih-Yaw Lai	DOW-8544-CJ	7684
29423	7590	02/11/2004	EXAMINER	
WHYTE HIRSCHBOECK DUDEK S.C. 555 EAST WELLS STREET SUITE 1900 MILWAUKEE, WI 53202			RABAGO, ROBERTO	
			ART UNIT	PAPER NUMBER
			1713	

DATE MAILED: 02/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

mk

Office Action Summary

Application No.

10/727,970

Applicant(s)

LAI ET AL.

Examiner

Roberto Rábago

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41-43 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 41-43 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the next number following the highest numbered claim previously presented (whether entered or not). This application was filed with original claims 1-40. A preliminary amendment was filed 12/4/2003 containing new claims 103-105, yet there is no record in this application of any claims numbered 41-102. Therefore, the numbering is not in accordance with 37 CFR 1.126 because the newly added claims have not been numbered consecutively beginning with the next number following the highest numbered claim previously presented. In the event that applicants believe claims numbered 41-102 were filed in this application, then such papers should be re-presented with proper evidence of submission. In the event that applicants began the new claim numbering with claim 103 in view of the prosecution history of a parent case, applicants are advised that the details of how claims were added or cancelled in a prior application has nothing to do with the numbering in this application. Claim numbering in this application is based solely on claims which have been presented in this application.

Misnumbered claims 103-105 have been renumbered 41-43.

Specification

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 41-43 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 and 12-18 of copending parent Application No. 10/270,212, and claim 65 of copending Application No. 10/354,416, and claims 65-72 and 85-88 of copending Application No. 10/176,304. Although the conflicting claims are not identical, they are not patentably distinct from each other because, in each case, the instant claims are more broad than the copending claims.

Art Unit: 1713

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 41-43 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 5,525,695, and claims 1-13 of U.S. Patent No. 5,380,810, and claims 1-15 of U.S. Patent No. 6,534,612, and claims 1-20 of U.S. Patent No. 6,136,937 and claims 1-10 of U.S. Patent No. 5,783,638. Although the conflicting claims are not identical, they are not patentably distinct from each other because, in each case, the instant claims are more broad than the patented claims.

6. No prior art has been located which anticipates or renders obvious the subject matter of the instant claims. The closest prior art is Canich et al. US 5,096,867, wherein catalysts similar to those used to make the claimed polymers have been disclosed for polymerization of olefin monomers. However, neither the general disclosure nor the working examples provide sufficient details of polymer properties to conclude that the reference polymers have the claimed properties. Also of interest is Tsutsui et al. US 5,336,746 wherein metallocenes have been used to polymerize olefins. Several examples disclose copolymers with the claimed I_{10}/I_2 and M_w/M_n , but the reference has not disclosed similar properties for a homopolymer.

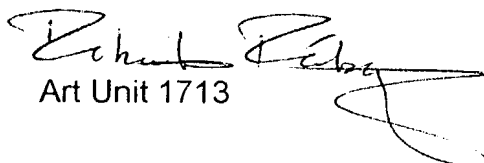
Art Unit: 1713

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberto Rábago whose telephone number is (571) 272-1109. The examiner can normally be reached on Monday - Friday from 8:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ROBERTO RABAGO
PATENT EXAMINER


Art Unit 1713

RR
February 3, 2004